



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/131,710 08/10/98 PAZ-PUJALT

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001333  
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IM52/0320

EXAMINER

GRENDZYNSKI, M

ART UNIT

PAPER NUMBER

1774

DATE MAILED:

03/20/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Advisory Action

Application No.  
**09/131,710**

Applicant(s)  
**Paz-Pujalt et al.**

Examiner  
**Grendzynski, Michael E.**

Group Art Unit  
**1774**



### THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 3 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

**Applicant's response to the final rejection, filed on Mar 5, 2001 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:**

- ☐ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
  - ☐ will not be entered because:
    - ☐ they raise new issues that would require further consideration and/or search. (See note below).
    - ☐ they raise the issue of new matter. (See note below).
    - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
    - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

- ☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_  
\_\_\_\_\_

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

- ☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
see attached sheet

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: \_\_\_\_\_

Claims objected to: \_\_\_\_\_

Claims rejected: 1 and 2

- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Other

Art Unit: 1774

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 3/5/01 have been fully considered but they are not persuasive. Applicants argue that the instant invention has two receiving layers, whereas the Bodager article comprises only one image-receiving layer. Applicants' reasoning is that examiner's interpretation of the phrase "recorded information" is unsupported, and that the Bodager water-absorbing layer does not, in fact, hold recorded information.

FIG. 1 of Bodager reveals a three-layered structure, an ink-receiving layer, a water-absorbing structure, and a support. *See* col. 12, line 66. It is the examiner's assertion that the water-absorbing layer is the equivalent of applicants' information-receiving layer because it does, in fact, hold recorded information, because the ink carrier medium (containing organic additives) passes through the ink-receiving layer, and into the water-absorbing layer, thus altering the optical properties of the layer. The examiner's interpretation of the phrase 'recorded information' is not unsupported. The phrase's broadest, reasonable interpretation is its plain English meaning. *Information*, as defined in *Merriam-Webster's Collegiate Dictionary* (<http://www.m-w.com/>), is the communication or reception of knowledge or intelligence such as data. To *record* is to cause something (such as sound, visual images, or data) to be registered onto something. The placement of the ink onto the Bodager reference leads to recorded information being present in both layers. Data, in the form of a composition which alters the optical property of the layer upon which it is applied, exists in both

Art Unit: 1774

layers. An ink need not be colored to be readable, whether by the human eye or an instrument. Applicants' arguments are not commensurate within the scope of the claims--Applicants are not claiming a colored image. The fact the "waste products" of Bodager may or may not contain colorant is not dispositive on the issue of patentability. Consequently, the examiner's interpretation of the phrase "recorded information", is not only supported, but consistent with the phrase's broadest, reasonable interpretation.

Applicants further argue that the end product of Bodager does not suggest the instant invention because (1) the hydrophilic layer of the instant invention is the top layer, not the middle layer, and (2) the end product is structurally different. Applicants are directed to FIG. 1, where a structure comprising a support, a water-absorbing layer, and an ink-receiving layer is disclosed. As stated in the record, the Bodager ink-receiving layer is equivalent to applicants' hydrophilic layer--both are comprised of gelatin. Gelatin is hydrophilic. Moreover, the fact that the structure of Bodager is manipulated *after* its creation, does not patentably distinguish the instant invention.



BRUCE H. HESS  
PRIMARY EXAMINER